

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/698,659 Confirmation No. 4437
Applicant : James A. Leistra
Filed : 10/31/2003
TC/A.U. : 1762
Examiner : Elena Tsoy
Docket No.: 03-292
Cust. No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

REASONS FOR PRE-APPEAL BRIEF CONFERENCE REQUEST

Dear Sir:

This paper is submitted accompanying a Notice of Appeal and a Request for Pre-Appeal Brief Conference.

The Final Office Action of June 21, 2007, from which appeal has been taken, rejects these independent claims (1) as obvious over Wessel et al., (2) as obvious over Asukabe et al. in view of Wessel et al., and (3) as obvious over Menjak et al. Each of these rejections totally ignores a critical limitation in the claims and is therefore flawed. The application should either be allowed or remanded for further non-final examination.

Each of claims 1 and 25 clearly calls for an electrodes, a membrane between the electrodes, and a layer between the membrane and at least one of the electrodes. The claim calls for the layer to be a peroxide decomposition layer, specifically calls for the positive method step of depositing that layer, and calls for that layer to have different properties from the electrode in terms of porosity.

In rejecting claims 1 and 25, the Examiner relies upon Wessel et al. The Examiner recites teaching from Wessel et al. that all fuel cells have a gas-permeable, porous, so-called three-dimensional electrode whereas the membrane (electrolyte) present in all fuel cells forms a gas-tight barrier between the two electrodes. The Examiner then makes a leap to state that "since a layer comprising a catalyst is located between electrode and membrane, it should have porosity of either electrode or porosity of a gas-tight (claimed

porosity of less than 20%) membrane". This is flawed in a number of ways. First, the layer referred to is part of the electrode, not a layer between the electrode and the membrane. The layer referred to be the Examiner is part of the "gas-permeable, porous, so-called three dimensional electrode" referred to be the Examiner. It has the porosity of the electrode, which is different from the limitations in claims 1 and 25 in two important respects, one which calls for the layer to have a different porosity from the electrode and the other calling for the layer to have a porosity of less than 20%.

The layer called for by claims 1 and 25 is simply put totally absent from Wessel et al. This rejection completely ignores the layer called for in claims 1 and 25, and it therefore clearly in error.

The rejections based upon Asukabe et al. and Menjak et al. each in view of Wessel et al., recite the same reasoning concerning the teachings of Wessel et al., and therefore these rejections are similarly flawed and improper.

Based upon the foregoing, and keeping in mind that the present application is drawn to method claims corresponding to apparatus claims of similar scope which have already been allowed and granted in commonly owned US Patent 7,112,386, it is submitted that the claims of the present application are clearly allowable over the art of record. Allowance or remand is appropriate and earnestly solicited.

This paper is accompanied by a Notice of Appeal and Request for Pre-Appeal Brief Conference, along with authorization of the fee for appeal and an extension of time. It is believed that no other fee

10/698,659
Paper dated Dec. 21, 2007

is due. If any additional fee is due, please charge same to deposit account 02-0184.

Respectfully submitted,

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December 21, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03-292													
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 2px;">Application Number</td> <td style="padding: 2px;">Filed</td> </tr> <tr> <td style="padding: 2px;">10/698,659</td> <td style="padding: 2px;">10/31/2003</td> </tr> <tr> <td colspan="2" style="padding: 2px;">First Named Inventor</td> </tr> <tr> <td colspan="2" style="padding: 2px;">Leistra, et al.</td> </tr> <tr> <td style="padding: 2px;">Art Unit</td> <td style="padding: 2px;">Examiner</td> </tr> <tr> <td style="padding: 2px;">1762</td> <td style="padding: 2px;">Tsouy, Elena</td> </tr> </table>		Application Number	Filed	10/698,659	10/31/2003	First Named Inventor		Leistra, et al.		Art Unit	Examiner	1762	Tsouy, Elena
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>															
<p>I am the</p> <table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06) <input checked="" type="checkbox"/> attorney or agent of record. 34,309 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td style="width: 50%; vertical-align: top;"> /george a. coury _____ Signature George A. Coury _____ Typed or printed name 203-777-6628 _____ Telephone number December 21, 2007 _____ Date </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06) <input checked="" type="checkbox"/> attorney or agent of record. 34,309 Registration number _____ <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	/george a. coury _____ Signature George A. Coury _____ Typed or printed name 203-777-6628 _____ Telephone number December 21, 2007 _____ Date										
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<input checked="" type="checkbox"/> *Total of <u>2</u> forms are submitted.															

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.